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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/553,738 04/20/00 LUNDQUIST

I A-59616-4/HC

EXAMINER

QM12/1228

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ART UNIT

PAPER NUMBER

3763

DATE MAILED:

12/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/553,738

Applicant(s)

LUNDQUIST ET AL.

Examiner

Michael M. Thompson

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 14-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of the species requirement mailed 09-26-2000 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that several embodiments have similarities. This is not found persuasive because while there can be similarities in different embodiments, this does not preclude them from separation in a species requirement, the Examiner imposed a species election while it appears that Applicant's argument is more appropriate for a restriction requirement. However, the Examiner would like to remind Applicant of the possibility for a rejoinder upon proper arguments for a generic claim, and the finding of allowance of independent claim with appropriate dependency of different species.

The requirement is still deemed proper and is therefore made FINAL.

Information Disclosure Statement

2. The information disclosure statement filed 04-20-2000 doesn't have a legible copy of each publication as listed in the non-Patent literature. While Applicant more than likely filed these documents in a previous case, the most recent in the family history Application number 09/085,313 doesn't contain these documents. While the U.S. copies are easier to retrieve, the Examiner would like to request a supplemental copy of the "other" documents and the Examiner will review and mail a signed copy to Applicant. It has been placed in the application file, but the information referred to therein have not been considered.

Claim Objections

3. Claims 14-30 are objected to because of the following informalities: The Examiner has treated the claims as being replete with means plus function language. However, the Examiner requires that Applicant amend the specification pursuant to 37 CFR 1.75(d) and MPEP 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. See 35 U.S.C. 112, sixth paragraph states, "...and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Please note, MPEP 2182 states, "Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means-plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the PTO may still require the Applicant to amend the Specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 14-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Desai ('002).

Desai teaches a treatment device assembly for an endoscopic surgical instrument comprising a

needle/electrode, a means for guiding the needle/electrode, a control structure means for extending and retracting the needle/electrode, a means for interlocking said assembly to a housing, a means for deflecting the needle/electrode at an angle from the primary axis, a means for guiding having a bendable sheath, having a wire, first and second ends, means for tensioning said wire, means for deflecting in a curved end, means for supplying radio frequency energy, and a laser fiber optic disposed in the axial lumen of a needle.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 14-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims in U.S. Patent No's. 6,102,886; 5,848,986; 5,531,677; 5,409,453; 5,370,675; 5,435,805; 5,421,819; 5,385,544. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No's. *supra* are highly similar to the instant application in that both clearly teach a treatment device assembly for an endoscopic surgical instrument comprising a needle, a means for guiding the needle, a control structure means for extending and retracting the needle, a means

for interlocking said assembly to a housing, a means for deflecting the needle at an angle from the primary axis, a means for guiding having a bendable sheath, having a wire, first and second ends, means for tensioning said wire, means for deflecting in a curved end, means for supplying radio frequency energy.

8. Claims 14-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 5,861,002. Although the conflicting claims are not identical, they are not patentably distinct from each other because as described above, Applicant teaches a treatment device assembly for an endoscopic surgical instrument comprising a needle/electrode, a means for guiding the needle/electrode, a control structure means for extending and retracting the needle/electrode, a means for interlocking said assembly to a housing, a means for deflecting the needle/electrode at an angle from the primary axis, a means for guiding having a bendable sheath, having a wire, first and second ends, means for tensioning said wire, means for deflecting in a curved end, means for supplying radio frequency energy, and a laser fiber optic disposed in the axial lumen of a needle.


Contacts

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Thompson whose telephone number is (703) 305-1619. The Examiner can normally be reached on Monday through Friday from 9 am to 5 PM.

Any questions pertaining to informal matters such as the status of a case, missing portions of an Office Action, references, filing, paper matching, etc., should be directed to the Examiner's Legal Instruments Examiner (LIE), Tammy Holland, at (703) 305-2389.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Primary, AnhTuan Nguyen, can be reached on (703) 308-2154. The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4520.

Michael M. Thompson
Patent Examiner


ANHTUAN T. NGUYEN
PRIMARY EXAMINER

MT 

December 20, 2000